



PATENT
Attorney Docket No. 98088X207433

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hung et al.

Application No. 09/715,634

Filed: November 17, 2000

For: CERIA COMPOSITIONS AND
PROCESS FOR PREPARING
SAME

Art Unit: 1773

Examiner: Sheeba Ahmed

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated September 6, 2002, which sets forth a restriction requirement, Applicants elect, with traverse, the invention of group II (i.e., claims 34-52) for further prosecution. Applicants respectfully submit that the restriction requirement is improper, in whole or in part, for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see M.P.E.P. Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see M.P.E.P. Section 806.05 - Section 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see M.P.E.P. Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

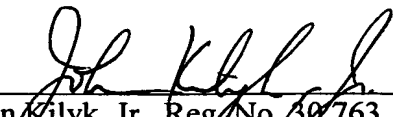
With respect to the present application and the outstanding restriction requirement, group I includes pending claims 1-33 and 53-55, which pertain to a method of preparing a cerium oxide particle composition. Group II includes pending claims 34-52, which pertain to a cerium oxide particulate composition. A comparison of the claims of groups I and II makes it abundantly clear that the claims of the two groups have quite similar subject matter and overlap to such an extent that there will be no serious burden on the Examiner to search and examine all of the pending claims (i.e., claims 1-55) at the same time.

For example, please see the description of the cerium oxide particulate composition in claim 34 (of group II), which pertains to a cerium oxide particulate composition comprising aggregates consisting essentially of approximately spherical primary particles of cerium oxide, and note how similar it is to the description of the product produced by the process of claim 1 (of group I), which also is a cerium oxide particle composition comprising aggregates consisting essentially of approximately spherical primary particles of cerium oxide. Additionally, please note the similarity of the description of the cerium oxide particulate composition of claims 34-50 (of group II) and of the particle composition produced by the process of claims 3-6 and 21-32 (of group I). Each of these claims specifically recites the shape, relative amounts, diameter, density, or surface area of the primary particles or aggregates comprising the same cerium oxide particulate compositions. These many relationships between the claims of the two groups illustrate that there would be no serious burden on the Examiner to search and examine the claims of group II at the same time as searching and examining the claims of elected group I.

In view of the foregoing remarks, Applicants respectfully request withdrawal of the restriction requirement, such that all the pending claims are considered together. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

In re Appln. of Hung et al.
Application No. 09/715,634

Respectfully submitted,



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Date: September 26, 2002

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: September 26, 2002

